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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER	
NGUYEN, THUY-VI THI	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/678,464
Filing Date: October 03, 2003
Appellant(s): BRESNIKER ET AL.

John P. Wagner, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/28/10 appealing from the Office action mailed 01/29/10

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is essentially correct with the additions set forth below:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means (or step) plus function limitation: "*means for controlling automatic retrieval of rack equipment related information from at least one component….rack of equipment" and "means for processing information and instructions, wherein said means for processing information and instructions is configured for processing ……equipment information*".

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see Altiris Inc. v. Semantec Corp., 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an

adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. Aristocrat Technologies, Inc. v. International Game Technology, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. WMS Gaming,Inc. v. International Game Technology, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. Aristocrat, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function:

[Figure 3, depicts "Description Retrieval Module 321" and pages 13, lines 15-25, recites "a rack equipment description retrieval module 321 controls automatic retrieval of rack equipment description information"]

[Figure 3, depicts "Repository management component 320", and pages 10, lines 23-26 recites "repository management component 320 manages information flow to and from equipment description information repository 311 and management plan information 312"; pages 12, lines 15-25 recites "Repository management component

320" can retrieve the equipment information, can interface with a database of client information and extract information associated with a rack equipment management plan information"].

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. It appears that the rack equipment information is controlled by a retrieval module 321, and the characteristics of the rack equipment is processed and managed by a "repository management component 320". However, the specification does not describe how the rack equipment information is controlled, processed and managed. Specially, the specification does not provide the algorithm for the claimed means for controlling, processing as such appellants have failed to adequately describe sufficient structure for performing the functions claimed.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon the rejection of claims under appeal:

O'Kane, Jr. et al. Patent No.: US 6,366,919, filed on May 30, 2001.

Applicant Admitted Prior Art (AAPA) {pars. 0004-0007}.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'KANE, JR. ET AL. (US 6,366,919).

As for independent claim 1, O'KANE, JR. ET AL. disclose a computer implemented rack equipment management information coordination method comprising:

a) designing or arrangement or configuration of a rack equipment management plan using a computer, the rack equipment management plan includes information data such as equipment management and usage policies and establishes an association between a rack equipment performance action and a trigger

{see col. 2, lines 33-39 discloses the *creating designs of racks using a performance characteristics of the telecom equipments*; at least figures 3, 5, 7, 12-13 and at least col. 5, lines 47-59; col. 7, lines 64-67, col. 8, lines 1-6; and lines 1-2; col. 9, lines 1-16, and lines 38-67 wherein O'KANE ET AL discloses the arrangement of a rack equipment management plan, and usage policies for example:, a determination as to what the environmental *factors applicable to the site is made such as available cooling power, humidity level*, the design of rack *to determine when* and *if a particular design*

exceeds acceptable parameter values such as power, cooling, dimensions and positional requirements (interpreted to be rack equipment plan) and col. 5, lines 47-59 discloses *the total power demanded by all of the telecom components in a particular rack does not exceed a certain portion*, such as 80% of the power supply in the rack (interpreted to be usage policies) ; and col. 4, lines 1-9 discloses the telecom equipment power requirements, heating loads or power consumed telecom ports, *performance capabilities*, form factors needed to mount the *telecom equipment in racks*}

and wherein said rack equipment management plan is a plan for managing rack equipment operating characteristic while said rack equipment is in operation;

{see figures 3-5, 7, 10-11}

b) automatically detecting/monitoring and retrieving using computer, rack equipment description information from at least one component comprising said rack equipment, wherein said rack equipment descriptive information comprises an identification of equipment type of said at least one component;

{see figures 1 and 5, at least col. 6, lines 15-53; col. 8, lines 7-10 discloses the automatically detecting and retrieving the operation information or power load for the equipment on the rack. For example: "*An automatic determination at the central computer 22 to determine whether any one configuration of telecom equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106. Accordingly DC power loads are carefully monitored and conditions, batter data 108, of the back-up batteries 106 are continually surveyed and*

reported to the central computer 22 by the technicians or automatically as suggested at 110 through the use of micro possessor 112 coupled to the network 24}.

{see figures 1 and 3; ,abstract; col. 2, lines 14-54; col. 4, lines 4-17; col. 7, lines 64-67; col. 8, lines 1-35 discloses the databases for storing the rack of telecommunication equipment information in the database, performance data for particular telecom equipment may be stored

c) storing with said computer, aid rack equipment description information and said rack equipment management plan

{see figures 1,abstract; col. 2, lines 14-54; col. 4, lines 4-17; col. 7, lines 64-67; col. 8, lines 1-35 discloses the databases for storing the rack of telecommunication equipment information in the database, performance data for particular telecom equipment may be stored}.

{see col. 5, lines 34-46 wherein O'KANE, JR. ET AL discloses the rack equipment description information are stored in the databases 26 and 28, the telecom component information (equipment description) such as listing of the particular telecom components such as switches, optical fiber, connectors, power supplies}.

O'KANE, JR. ET AL discloses the claimed above except for the feature "wherein at least a portion of the information/data such as equipment management plan and usage polices are automatically received from a customer database" (part of step a). However, O'KANE, JR. ET AL disclose a computer center is connected to various client database, the client/customer access to various database through the network to determine or verify the actual installations, various activities on the equipment and

system, updated and maintained current} {see at least figures 1-2, 6A (site information by client 26), abstract, col. 2, lines 43-54, lines 65-67, col. 3, lines 1-2; col. 5, lines 7-13}.

Therefore, it would have been obvious to one of ordinary skill in the art to provide the system of O'KANE, JR. ET AL to including receiving information from the customer database in order to provide a sufficient telecommunication site management system for tracking and updating the status of the equipments at remote sites by receiving equipment information from the customer through the network.

Furthermore, this appears to be a "data processing" method, therefore, the data or information such as "*equipment management and usage policies, rack equipment performance action and a trigger event* (1st step), *an identification of equipment type* (2nd step)*"* have been determined to be non-functional descriptive material (NFDM). For example, as for the information "an identification of equipment type" in the second step, there is no functional relationship between this data and the action of detecting and retrieving. In other word, the claim is broad enough that the detecting and retrieving steps may for example merely look to a particular memory location for the present of any data and retrieving or stored that data. Thus, analysis is required of the type of data within the scope of the claim.

Therefore, this data such "an identification of equipment type" have no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983)

(when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claims 2-3, which discloses the retrieving performance level setting from the rack equipment, e.g. wattage setting; this is fairly taught in O'KANE, JR. ET AL, see figures 11-13.

As for claims 4-5, which discloses the information or guidelines e.g. power and thermal budge guidelines about the rack equipment management plan, this is fairly taught in O'KANE, JR. ET AL, see at least col. 5, lines 48-59.

As for claim 6, which discloses interfacing with a service agreement application for formulating the rack equipment plan, this is fairly taught in O'KANE, JR. ET AL {see figures 3, 6 col. 14-27 e.g. CAD drawing"}

As for claim 7, which discloses integrating said rack equipment description information with said rack equipment management plan, this is fairly taught in O'KANE, JR. ET AL, figures 1, 5, 6A and 7.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8-16, 17- 20 are rejected under 35 U.S.C. 102(b) as being anticipated by O' KANE, JR. ET AL (US 6,366,919)

As for independent claim 8, O'KANE, JR. ET AL disclose a rack equipment information coordination system comprising:

a) an equipment description information repository/storage coupled with a computer,

{see figures 1, 3, database 26, 302 "*communication equipment is stored*"; see col. 3, lines 60-67; col. 5, lines 29-47}

b) a management plan information repository for tracking rack equipment management plan, and this repository/storage coupled with a computer,

{see figure 1, computer 22, and at least databases 30 and 32},

Furthermore, it appears that these limitations such as "wherein said rack equipment management plan information is used for managing rack equipment while said rack equipment is in operation and is configured for directing a change in operating characteristic of said rack equipment" in step b are also taught in O' KANE, JR. ET AL {see col. 7, lines 13-27, figures 6A " rack configuration, maintain and update" O'KANE, JR. ET AL disclose the management system for maintaining and updating/changing the rack of telecommunication equipment},

c) a coordination component [for coordinating said equipment description information and said rack equipment management plan information, said coordination component implemented by a processor of said computer which is program with instruction for performing said coordinating]

{see figure 1, col. 2, lines 14-54 discloses a computer center is connected either directly or through network such as internet to various databases. With the data stored in these data bases the installation, maintenance updating of the remote telecommunication sites, a client can access the various data bases through the network; and also see figures 1, 2, 3, 5, 10 and 11, col. 2, lines 33-40, col. 9 lines 1-27 disclose a databases of components representing various telecommunication equipment}

d) a repository management component for controls and retrieve the equipment description information and management plan information, this repository management component is couple to the computer;

{see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-53 discloses

the central computer 22 is *automatically* determining and monitoring the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106};

{see figures 1 and 3; ,abstract; col. 2, lines 14-54; col. 4, lines 4-17; col. 7, lines 64-67; col. 8, lines 1-35 discloses the databases for storing the rack of telecommunication equipment information in the database, performance data for particular telecom equipment may be stored and

Note: the system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of

structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997*). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Therefore, the phrase "*for tracking equipment description information, wherein said equipment description information comprises.....component of a rack equipment* (step a); and *for tracking equipment management plan information….operation*(step b); *for coordinating....for performing said coordinating* (step c); *that controls automatic retrieval of said equipment description….plan information repository*" (step d) in claim 8 is considered as intended use limitation for the system/device "repository/database and component", and thus having no patentable weight.

Furthermore, the "the information/data" about *"equipment description information, identification equipment type, equipment management plan information,"* have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art since this information are just stored in the repository/database or storage. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive

material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claims 9-14 which discloses the information e.g. characteristics of rack equipment support equipment, possible operation settings of rack equipment, operating power levels and heat level, performance level information, guideline information, trigger event and management objective which are stored in the repository/database, this is taught in O'KANE, JR. ET AL, {see figures1, 7, 11-12, col. 3, lines 60-67, col. 4, lines 1-10, col. 8-10, col. 9, lines 50-67}.

Furthermore, the "the information/data" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 15, which deal with the coordination component provides a correlation between policies associated with a particular client and rack equipment implementing the client's application, this is taught in O'KANE, JR. ET AL {see figure 13, col. 3, lines 45-47, col. 8, lines 66-67, col. 9, lines 1-28, disclose the configuration and generating the rack equipment images suing the CAD application}

As for claim 16, O'KANE, JR. ET AL disclose further comprising:

a repository management component for managing information flow to and from said equipment description information repository and said management plan information repository;

{see figures 1, col. 3, lines 50-67, col. 4, lines 1-10, and lines 33-39 O'KANE, JR. ET AL disclose the management system databases for managing and maintaining the rack of telecommunication equipment and management information}

a communication link for communicating information to and from said repository management component {see figures1, 4, net work link 24, col. 3, lines 60-67}.

Note: the system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)*. Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, in an apparatus claim, i.e. the phrase "for managing and for communicating" in claim 8 is considered as intended use limitation for the system/device "repository/database", and thus having no patentable weight.

As for claim 17, O'KANE, JR. ET AL disclose a computer system comprising:

a) means for controlling automatic retrieval of rack equipment related information e.g. rack equipment description information, an identification of equipment type of a rack of equipment;

{see figures 1, 5, 7, 11-13 col. 4, lines 4-9; col. 7, lines 64-67; col. 8, lines 1-35 wherein O'KANE, JR. ET AL discloses automatically *monitored* the telecommunication equipment e.g. the rack servers 94.1-94.4 which comprise communication equipment 100 such as power supply, power distribution panel, identification what racks are present at the sites and identification of equipment installed at the sites as well as in which racks; and also see figure 13 for the rack equipment description; and the central computer 22 is *automatically* determining and monitoring the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106 {see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-30, lines 40-53}.

{see col. 5, lines 34-46 wherein O'KANE, JR. ET AL discloses retrieving data or telecom component information from the databases such as 26 and 68. The telecom component information (equipment description) such as listing of the particular telecom components such as switches, optical fiber, connectors, power supplies};

b) a means for communicating rack equipment related information [for managing rack equipment while said rack equipment is in operation],

{see figures 1, 2, 5, 10 and 11, col. 3, lines 50-67, and lines 55-60 and col. 8, lines 1-10, O'KANE, JR. ET AL disclose a communication device in the *computer 22 to*

communicate with various databases which stored the information related to the rack telecommunication equipment and for monitoring, determining the rack to be installed from the telecommunication cites, e.g. *equipment power requirement, performance capabilities, data relevant to racks such as sizes, and shape*}.

c) a means for storing said rack equipment related information and instructions [for implementing rack equipment information coordination]

{see figures 1, 2, 3, 5, 10 and 11, col. 3, lines 50-67, col. disclose a communication device in the *computer 22 to communicate with various databases* which stored the information related to the rack equipment, e.g. *equipment power requirement, performance capabilities, data relevant to racks such as sizes, and shape*}.

d) a means for processing information and instructions, wherein said means [for processing information and instructions is configured for processing said instructions and for managing operating characteristics of said rack equipment, and is configured for processing information for managing said rack equipment information coordination]

{see col. 1, lines 16-23, col. 39-46, col. 2, lines 33-37, and col. 2, lines 55-60; at least figures 1, 5, 6A, 10 and 11, disclose the system for managing telecommunication sites/equipment and the rack of telecommunication equipment which enable remote maintenance and reconfiguration of existing equipment

Note: that the [...] is used to indicate intended use which has no patentable weight.

Furthermore, as for the this appears to be a "data processing" method, therefore, the data or information such as "*wherein said equipment descriptive information*

comprises an identification of equipment type .....rack of equipment" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 18, O'KANE, JR. ET AL disclose further comprising:

a) a rack equipment description retrieval module for controlling automatic retrieval of rack equipment description information {see figure 1, at least database 32, which stores telecommunication equipment in racks and data relevant to the racks}

b) a rack equipment management plan module for directing establishment of a rack equipment management plan {see figure 1, 6A, 11, and 13; col. 5, lines 35-59 "design and modify and develop telecommunication site];

c) a rack equipment correlation module for providing correlation instructions to a correlation component {see figures 1, 2, 6A, 10-11}

d) an instruction saving module for directing rack equipment description information and the rack equipment management plan information saving operations {see figure 1}

Note: the system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally,

claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)*. Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, in an apparatus claim, i.e. the phrase "for controlling..; for directing....; for providing...." in claim 18 is considered as intended use limitation for the system/device "module", and thus having no patentable weight.

As for claim 19, which discloses the rack equipment management plan module facilitates determination of rack equipment management objectives, this is taught in O'KANE, JR. ET AL {see figures 6A, and 13}

As for claim 20, which discloses the rack equipment management information coordination, is utilized to support a variety of rack equipment management objectives, this is taught in O'KANE, JR. ET AL {see figures 1, 6A and 13}.

5. Claims 8-16, 17-20 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over O'KANE, JR. ET AL. **(US 6,366,919)** in view of Applicant Admitted Prior Art **(AAPA)** {pars. 004-0007} or vice versa.

As for independent claim 8, the teaching of O' KANE, JR. ET AL is cited above. AAPA is cited to show an equipment management information system wherein the

equipment is about rack equipment. It would have been obvious to modify the system of O' KANE, JR. ET AL by using other equipment type such as rack equipment as taught by AAPA as mere applying the same information management to other similar equipment.

Alternatively, the teachings of AAPA is cited above. It would have been obvious to modify the manual equipment management information system of AAPA by using the computer automatic equipment management information system of O' KANE, JR. ET AL for the benefits of "*managing ....which enable remote maintenance and reconfiguring of existing equipment ....desired is a system which tracks and updates the content, arrangement, configuration, …maintenance.*" {see col. 1, lines 39-45}.

As for dep. claims 9-16, they are rejected for the same reasons set forth above to avoid duplicate rejections.

As for independent claim 17, which has similar scope to independent system claim 8 above, it's rejected for the same reason set forth in the rejection of claim 8 above.

As for dep. claims 18-20, they are rejected for the same reasons set forth above to avoid duplicate rejections.

(10) Response to Argument

I) With respect to claims 1-7 under 35 USC § 103 rejections:

Appellant's comment on pages 12-16 that the reference of O'Kane does not teach or suggest "automatically detecting and retrieving, with said computer, rack equipment description information from at least one component comprising said rack

equipment, wherein said rack equipment description information comprises an identification of equipment type of said at least one component" (2nd step of claim 1). Appellants argued:

1) "O'Kane may describe automatically determining and monitoring a power load on a rack (col. 6, lines 40-53 of O'Kane). However, the automatic monitoring of O'Kane only automatically monitors operation information (such as temperature or DC power load), and this is very different than "automatically detecting and retrieving.....at least one component" as recited in claim 1".

2) O'Kane only discloses the identification of the equipment type is manually retrieved, and it is required to take place before any sort of monitoring can occur. O'Kane discloses any rack equipment description information that comprises "an identification of equipment type" would have been manually entered into such a database rather than automatically retrieved from the component as specified in claim 1. Therefore, Appellants submit that retrieving equipment information by manual survey or retrieving information such as DC power load, temperature, or humidity only after a survey as show in O'Kane is very different from and does not teach or suggest the "automatically detecting and retrieving.....component" as recited in claim 1.

3) Appellants also pointed out on page 16 regarding to the feature "*an identification equipment type*" is determined as non-functional descriptive material in the office action is improper because "no analysis was provided other than an indication that claim 1 appeared to be a data processing method". Appellants indicates in claim 1, "while the description information is eventually stored, the particular equipment

description information that comprises and identification of equipment type of at least one component first has to be automatically detected and retrieved from the at least one component. Therefore, identification of equipment" is functionally related to what is automatically detected and retrieved from a component".

However, the above arguments are not persuasive for the following reasons:

1) In claim 1, second step recites, "automatically detecting and retrieving, with said computer, rack equipment description information from at least one component comprising said rack equipment, wherein said rack equipment description information comprises an identification of equipment type of said at least one component", O'Kane figures 1 and 5, col. 6, lines 15-53; col. 8, lines 7-10 discloses the automatically detecting and retrieving the operation information or power load for the equipment on the rack. For example: "*An automatic determination at the central computer 22 to determine whether any one configuration of telecom equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106. Accordingly DC power loads are carefully monitored and conditions, batter data 108, of the back-up batteries 106 are continually surveyed and reported to the central computer 22 by the technicians or automatically as suggested at 110 through the use of micro possessor 112 coupled to the network 24*}. Therefore, in order for the automatic determination to be at the central computer, the information must be detected and retrieved from the rack equipment.

2) As for the limitation "wherein said rack equipment description information comprises *an identification of equipment type* of said at least one component", the type

of data such as "*an identification of equipment type*" is determined to be non-functional descriptive material (NFDM) since there is no functional relationship between this data and the action of detecting and retrieving. In other word, the claim is broad enough that the detecting and retrieving steps may for example merely look to a particular memory location for the presence of any data to retrieve and store that data. Thus, no analysis is required of the type or content of data within the scope of the claim.

3) For the sake of argument, assuming the data "an identification of equipment type" is functional, O'Kane discloses in col. 6, lines 41-53 about the operation information of the rack equipment such as condition of power loads, battery data, back-up batteries are surveyed and reported to the central computer by technicians or automatically. Thus, the reference contemplates or recognizes that such data could be collected manually or automatically. While equipment type information is described in the reference as being collected manually (col. 4, lines 41-50), the teachings of O'Kane shows manual and automatic data collection as alternative. Further, it has been held that automating a manual activity would have been obvious to an ordinary skill in the art. See MPEP 2144.04 section 3 "Automating A Manual Activity". See In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Therefore, considering the means already taught by O'Kane to automatically collect data, the use of manually and automatically data collection as alternative, and also considering the obviousness of automation, it would have been obvious to automate the collection of equipment type data, which done manually by O'Kane for the well known convenience of automation data collection.

II) With respect to claims 8-20 under 35 USC § 102(b) rejections:

As for claim 8, Appellant's comment on pages 18-20 that the reference of O'Kane does not teach or suggest "a repository management component that controls automatic retrieval of said equipment description information and said management plan information such that said identification of equipment type is automatically retrieved by said repository management component from said at least one component of rack equipment". Similarly to the arguments on claim 1 above such as automatic retrieval in O'Kane (if performed) appears to be limited to retrieving operation information (col. 6, lines 40-53) such as a DC power load rather than equipment description information such as equipment type, and O'Kane shows a retrieval process involve a survey request for manual collection and population of equipment identification information such as equipment type is very different that the recited claim 8.

However, these arguments are not persuasive for the following reasons:

1) O'Kane shows in figures 1 and 5, col. 6, lines 15-53; col. 8, lines 7-10 a component "computer 22" that controls automatic retrieval the operation information on the rack equipment. For example: "*An automatic determination at the central computer 22 to determine whether any one configuration of telecom equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106. Accordingly DC power loads are carefully monitored and conditions, batter data 108, of the back-up batteries 106 are continually surveyed and reported to the central computer 22 by the technicians or automatically as suggested at 110 through the use of micro possessor 112 coupled to the network 24*}. Therefore, in

order for the automatic determination to be at the central computer, the information must be detected and retrieved from the rack equipment.

2) It is noted that claims 8-20 appear to be system claims and are written using functional language. The system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997*). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Since the system of O'Kane discloses a structure or component which controls automatic retrieval information such as operation information of rack equipment as cited above (section II, par. 1), thus this system is also capable of performing the functions of automatic controlling and retrieving any type of information such as operation information of rack equipment, or identification equipment type. In other words, the claimed limitation and the system of O'Kane appear to be no structure different between the "component" that control automatic retrieval of operating information of rack equipment. Noted that claim 8 is broad with respect to the automatic retrieval is

performed, e.g. merely accessing a memory location. As a result, no structure distinction is found since the system of O'Kane must retrieve information from the rack equipment in some manner.

Therefore, O'Kane discloses the limitation "a repository management component that control.....rack equipment" as recited in claim 8.

As for claim 17, Appellants again points out (pages 21-23) that O'Kane does not teach "a means for controlling automatic retrieval .....at least one component of a rack equipment", and the feature "an identification of equipment type" is not Nonfunctional Descriptive Material as it describes the function of the means. However, these arguments are not persuasive for the similar reasons as indicated in claim 1 (section I, pars. #1 and #2) and claim 8 (section II, pars. #1 and #2) above.

III) With respect to claims 8-20 under 35 USC § 103 rejections:

As for the arguments on pages 25-28, similarly as the arguments about "a repository management component" as recites in section II above, and it is also not persuasive based on the similar reasons as shown in section II above. Furthermore, Appellant submits that "a manual identification of equipment type of a component would teach a way from the claimed automated retrieval of equipment identification". However, this is not persuasive because the reference of O'Kane or AAPA does not criticize, discredit, or discourage the automated retrieval of equipment information. See MPEP 2141.02 section VI shows in particular the discussion of In re Fulton, where

reference did not teach a way because it did not "criticize, discredit, or otherwise discourage the solution claimed..."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains **a new ground of rejection** set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully Submitted,

/*Thuy Vi Nguyen*/

Examiner, Art Unit 3689

Conferees:

1) Janice Mooneyham

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

2) Jamisue Plucinski

/Jamisue A. Plucinski/

Supervisory Patent Examiner, Art Unit 3629

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600